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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/816,393	03/26/2001	Funitomo Matsuoka	205173US2S	7222
22850	7590	01/21/2004		
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER TOLEDO, FERNANDO L	
			ART UNIT 2823	PAPER NUMBER

DATE MAILED: 01/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/816,393	Applicant(s) MATSUOKA, FUNITOMO	
	Examiner Fernando Toledo	Art Unit 2823	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 December 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-3,5-10,12 and 13.

Claim(s) withdrawn from consideration: 14-18.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


George F. Fournier
Patent Examiner

Continuation of 5. does NOT place the application in condition for allowance because: Applicant contests that Figures 7 and 8 are not Applicant Admitted Prior Art. The Examiner finds that Applicant's position to be puzzling. For examination purposes, it is customary for all art disclosed in the background section of an application to be considered admitted prior art regardless of the terminology used by the Applicant. If some of the disclosed art is not prior art under 35 USC 102 then it is incumbent on the Applicant to clearly distinguish that which is prior art from that which is not. Further, 37 CFR 1.56 clearly states that each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability. Because Applicant has not clearly established which of the "background art" is not prior art, all of the art in the background section will continued to be presumed admitted prior art. Clear statements that figures 7 and 8 are prior art can be found on page 1, lines 17 - 20 and on page 6, line 5. Applicant is not permitted to contradict the clear statements that figures 7 and 8 are prior art pointed to above absent a clear and convincing line of reasoning that the pointed statements are incorrect. See *In re Ruff* 118 USPQ 340. Applicant also contests that the etching of Yu is for the purpose of removing an oxide layer and not widening the trench. However, it is not necessary for the reference to disclose that the process of the reference is performed to achieve the same goals as applicant or to obtain the same advantages recognized by Applicant. It is sufficient that the process suggested by the reference alone or in combination with the remaining references is encompassed by the instant claims. Yu discloses in column 4, lines 48 and 49 that the etchant used is "selective to oxide to reach the top surface of the substrate." This statement clearly discloses that the etchant used by Yu reads over the limitation of the "etching selectivity between an insulating film and a semiconductor substrate."